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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,973	08/29/2000	Norbert George Vogl	YOR920000532US1	9168

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EXAMINER

BAROT, BHARAT

ART UNIT PAPER NUMBER

2155

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/649,973

Applicant(s)

VOGL ET AL.

Examiner

Bharat N. Barot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1-19 are drawn to a method of doing business over a network including: predicting transmission time based on a number of packet (size) and a network speed, classified in class 709 subclasses 223-224 and 227-228.
 - II. Claims 20-22 are drawn to a method of doing business over a network including: predicting transmission time, priority, and cost based on a size and a network capacity; and transmitting digital information based on the time, a source address, and an identification of a recipient, classified in class 709 subclasses 206-207 and 245-246.

Subcombinations, Useable Together

2. Inventions (I) and (II) are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable (MPEP § 806.05(d)).

In the instant case, Invention (I) has separate utility such as predicting transmission time based on a number of packet (size) and a network speed; and invention (II) has separate utility such as predicting transmission time, priority, and cost based on a size and a network capacity; and transmitting digital information based on the time, a source address, and an identification of a recipient and also has utility by itself or in other combinations (MPEP § 806.05(c)).

Conclusion To All Restriction Requirements

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election By Original Presentation

4. Newly submitted claims 20-22 (previously unclaimed subject matter) directed to an invention that is independent or distinct from the invention defined by the original patent claims 1-19 for the following reasons: See Sections 6-8.

Since applicant has received an action (non-final rejection) on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-22 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

RESPONSE TO AMENDMENT

5. Claims 1-19 (PREVIOUSLY PRESENTED) remain for further examination. Applicants' arguments with respect to claims 1-19 filed on December 06, 2004 have been fully considered.

The old rejection maintained

6. The rejection is respectfully maintained as set forth in the last Office Action mailed on September 17, 2004. Applicants' arguments with respect to claims 1-19 have been fully considered but they are deemed to be moot and old rejection maintained.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamoto et al (U.S. Patent No. 5,903,724) in view of Sherer et al (U.S. Patent No. 5,875,175).

9. As to claim 1, Takamoto et al teach a method of doing business over a network (see abstract; and figures 1-2) comprising the steps of: receiving a request for transmitting digital information, the digital information having a number of packets; determining the time required to transmit the digital information; scheduling a transmit time for the digital information; and accepting the digital information for transmission (figures 2, 9, and 15-17; column 6 line 65 to column 7 line 10; column 8 lines 13-36; and column 11 line 22 to column 12 line 54).

However, Takamoto et al do not teach the steps of: receiving, determining, scheduling, and accepting with specific conditions.

Sherer et al teach a method of doing business over a network (see abstract; and figures 3A-3B) comprising the steps of: receiving a request for transmitting digital information after a start time and before an end time, the digital information having a number of packets (figures 3B and 4; column 3 line 54 to column 4 line 3; column 6 line 40 to column 7 line 11; column 9 lines 15-31; and column 11 lines 6-18); determining the time required to transmit the digital information based on the number of packets and a network speed; scheduling a transmit time for the digital information (figures 3A-3B; column 3 lines 26-53; and column 5 line 1 to column 6 line 39); and accepting the digital information for transmission only if the time required to transmit is less than or equal to the difference between the transmit time and the end time (column 9 lines 32-40; and column 9 line 61 to column 10 line 26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Sherer et al stated above in the method of Takamoto et al for doing business over a network as stated above because it would have optimized network performance and increased system efficiency by scheduling a transmit time for the digital information.

10. As to claims 2-3, Sherer et al disclose that the digital information is transmitted at a first price or the digital information is rejected for transmission if the time required to transmit is more than the difference between the transmit time and the end time (figure 3A-3B; column 9 lines 16-40; and column 10 line 48 to column 11 line 5).

11. As to claims 4-5; Takamoto et al disclose that the digital information is accepted for transmission at a second price; and the digital information is rescheduled by the scheduler and accepted for transmission at a second price after the information is rejected (figures 18-20; and column 12 line 55 to column 14 line 10).

12. As to claims 6-7, Takamoto et al disclose that receives an acknowledgment of the transmission (see summary of the invention; figures 2-3; and column 7 lines 10-63).

However, Takamoto et al do not disclose that produces a bill on receipt of the acknowledgment, but it would have been obvious and known to one of ordinary skill in the art at the time the invention was made to produces a bill on receipt of the acknowledgment (after providing a service) because it would have improved system management to determine the cost of network usage.

13. As to claims 8-10, Takamoto et al disclose that one or more portions of the digital information are accepted for transmission and are transmitted; and receives an acknowledgment of the transmission of one or more of the portions (see summary of the invention; figures 2-3; and column 7 lines 10-63).

However, Takamoto et al do not disclose that produces a bill on receipt of the acknowledgment for one or more of the portions, but it would have been obvious and known to one of ordinary skill in the art at the time the invention was made to produces a bill on receipt of the acknowledgment for one or more of the portions (after providing a

service) because it would have improved system management to determine the cost of network usage.

14. As to claim 11, Takamoto et al disclose that one or more portions of the digital information are initially rejected and then accepted for transmission at one or more second times and at one or more second prices (figures 18-20; and column 12 line 55 to column 14 line 10).

15. As to claim 16, Sherer et al disclose that the digital information is scheduled from one or more retransmissions if the time required to transmit is more than the difference between the transmit time and the end time (figures 4A-4B; and column 6 line 12 to column 7 line 47).

16. As to claim 17, Takamoto et al disclose that the digital information is scheduled from one or more retransmissions if no acknowledgment of the transmission of the digital information is received (figures 18-20; and column 12 line 55 to column 14 line 10).

17. As to claims 18-19, Sherer et al disclose that the digital information is also not transmitted if one or more criteria are not met, where the criteria include any one or more of the following: a file size, a release time, a deadline, zero or more recipients, zero or more user locations, an acknowledgment, a negative acknowledgment, a partial

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acknowledgment, a bandwidth, a quality of service, a retransmission count, and a retransmission schedule (column 3 lines 25-53; column 5 line 1 to column 6 line 39; and column 9 lines 16-40).

18. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamoto et al (U.S. Patent No. 5,903,724) in view of Sherer et al (U.S. Patent No. 5,875,175) as applied to claim 1 above, and further in view of Duquesnois et al (U.S. Patent No. 6,564,382).

19. As to claims 12-13, neither Takamoto et al nor Sherer et al discloses that the request has one or more priorities; the priority is that the digital information is transmitted within a time period.

Duquesnois et al disclose that the request has one or more priorities; the priority is that the digital information is transmitted within a time period (see abstract; column 2 lines 1-14 and 38-59; column 4 lines 44-52; and column 8 lines 5-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Duquesnois et al stated above in the method of Takamoto et al for doing business over a network as stated above because it would have increased over all system efficiency and performance.

20. As to claims 14-15, Duquesnois et al disclose that the time period in any one or more of the following: over night, two days, and one week, and the priority is a freight

priority that requires the digital information to be transmitted within a freight time period with no acknowledgments (see abstract; column 2 lines 1-14 and 38-59; column 4 lines 44-52; and column 8 lines 5-21).

Response to Arguments

21. Applicant's arguments with respect to claims 1-19 filed on December 06, 2004 have been fully considered but they are not deemed to be persuasive for the claims 1-19.

22. In the remarks, the applicant argues that:

(A) **Argument:** Neither Takamoto nor Sherer discloses or implies at least the subject matter in independent claim 1 of "accepting the digital information for transmission only if the time required to transmit is less than or equal to the difference between the transmit time and the end time."

Response: Sherer discloses that down-loads the packet for transmission if the real-time (the difference between the transmit time and the end time) is greater than or equal to the schedule time (time required to transmit) (column 9 lines 32-40; and column 10 line 48 to column 11 line 5) which is functionally equivalent to the claimed accepting step; therefore, the combination of Takamoto and Sherer does disclose the recited/argued subject matter.

(B) **Argument:** There is no motivation to combine Takamoto and Sherer, and improper to combine Takamoto and Sherer.

Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, incorporate the teaching of Sherer in the method of Takamoto for doing business over a network because it would have optimized network performance and increased system efficiency by scheduling a transmit time for the digital information (For motivation to combine see Sherer column 1 lines 9-22 and column 2 lines 38-54).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(C) **Argument:** Neither Takamoto nor Sherer recites the subject matter of the claims 2-5 and 7.

Response: Claim 2 Sherer discloses that packet (digital information) is transmitted at a real-time has a higher value than a schedule time (first price) (column 9 lines 32-40); and claim 3 does not transmit the packet on the network (the digital information is rejected for transmission) if the schedule time (time required to transmit) is greater than the real-time (the difference between the transmit time and the end time) (column 9 lines 32-40; and column 10 line 48 to column 11 line 5) which is functionally equivalent to the claimed subject matter.

Claims 4-5 Takamoto discloses that the digital information is rescheduled by the scheduler and accepted for transmission at a high speed (second price) after the information is not fully transmitted (rejected) (figures 19-20; and column 13 line 38 to column 14 line 10) which is functionally equivalent to the claimed subject matter.

Claim 7 Examiner took an official notice for the claimed subject matter.

(D) **Argument:** Duquesnois has nothing to do with the assignment of a priority level to digital information that is submitted for transmission.

Response: Duquesnois discloses that the priority is that the task (digital information) is executed (transmitted) within a time period (see abstract; column 4 lines 44-52; and column 8 lines 5-21) which is functionally equivalent to the claimed subject matter.

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23. This action is made final. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Contact Information

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached at (571) 272-4001.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

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June 14, 2005


BHARAT BAROT
PRIMARY EXAMINER